

The Examiner has rejected all of the claims on the grounds of obviousness-type double patenting over Claims 1-47 of the '595 patent to Lin et al. The Examiner objected to and rejected the Terminal Disclaimer filed October 17, 2005 to overcome this rejection on the grounds that there is no submission in the record establishing the ownership interests. The Examiner also indicated that a "Statement under 37 C.F.R. 3.73(b)" form was included with the Office Action. Again, Applicants did not find such form with the Office Action, but thank the Examiner for providing the PTO url for the form. A completed form is included with this response. Accordingly, Applicants request withdrawal of this rejection.

The Examiner has objected to the drawings. The Examiner asserts that Figures 3A-D are hard to understand. In particular, the Examiner objects to the figures showing in an isolated fashion the coupling of the membrane barrier to the pipette and syringe rather than showing a complete syringe having such slideable couplings. Applicants submit that the drawings are in fact perhaps clearer with this being shown in isolation rather than showing the entire syringe by thus allowing a more detailed view of the coupling which is the important aspect of the drawings. Applicants find these objections particularly perplexing given that three other applications containing the same drawings and description have previously granted, namely, U.S. Patent Numbers 6,360,595, 6,629,468 and 7,073,401. Accordingly, Applicants request the Examiner to reconsider and withdraw these objections.

The Examiner has rejected all of the claims under 35 U.S.C. § 103(a) over Wainwright and Moriarty. Applicants submit that there is no suggestion for making the alleged combination. The Examiner suggests that one of ordinary skill in the art would be motivated to modify the device of Wainwright with the filter of Moriarty in order to prevent contamination and have a securely mounted membrane within the pipette tube. Of course, the reasoning that one of ordinary skill in the art would be motivated by wanting to have a securely mounted membrane within the pipette tube is circular as Wainwright lacks such a membrane. Furthermore, the Examiner suggests that a filter would be desirable to prevent contamination. Applicants fail to find where in Wainwright contamination is of concern and this is fixing a problems which does not exist. Wainwright merely desires to draw sufficient fluid into the pipette to reach its sample.

Serial No. 10/042,904

Importantly, Wainwright does not seek to import a precise quantity of fluid. Wainwright has no need for such a filter, thus making its addition to Wainwright non-obvious.

Applicants submit that the application is presently in condition for allowance. Favorable reconsideration and early Notice of Allowance of the application are earnestly solicited. Applicants are filing a Notice of Appeal to preserve the case if the Examiner fails to issue a timely Notice of Allowance. If it would assist prosecution, the Examiner is encouraged to contact the undersigned attorney by telephone at the number listed below.

Respectfully submitted,

By: /Andrew C. Farmer/  
Andrew C. Farmer  
Reg. No. 35,868

Johnson & Johnson  
One Johnson & Johnson Plaza  
New Brunswick, NJ 08933  
(732) 524-2825  
Dated: May 23, 2007